

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/977,991 Confirmation No. 4493
Applicant : Bassam M. Hashem
Filed : October 17, 2001
TC/A.U. : 2617
Examiner : Nam Trung Huynh

Docket No. : 77682-62
Customer No. : 07380

**MAILSTOP AFTER FINAL
EXPEDITED HANDLING REQUESTED**

Commissioner for Patents
Alexandria, VA 22313-1450
U.S.A.

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the rejections set out in the Final Office Action dated February 20, 2009 in connection with the above-identified application. A Notice of Appeal has been submitted concurrently herewith.

In the Final Action dated February 20, 2009 the Examiner maintains the rejection of claims 1 to 15 under 35 U.S.C. 103(a) as being unpatentable over Ramos, et al. (US 7,072,663) (hereinafter "Ramos") in view of Shakhgildian (US 6,584,325). The Examiner concedes on page 3 that Ramos discloses that the candidate's target cell is chosen based upon a parameter such as total load which includes information on the uplink, down link, or both. In other words, a single candidate cell list is employed and one cell is chosen from the single list. A cell prioritization algorithm is employed to assign the "optimum target cell". The Examiner concedes Ramos does not teach the following:

storing an uplink candidate set listing at least one candidate uplink base station;

storing a downlink candidate set listing at least one candidate downlink base station; determining a predominant direction of traffic with respect to the terminal;

if the predominant direction of traffic is in an uplink direction, selecting at least one optimum base station from the uplink candidate set; and

if the predominant direction of traffic is in a downlink direction, selecting at least one optimum base station from the downlink candidate set.

In view of this, it is not readily apparent what the relevance of Ramos is at all.

Turning now to Shakhgildian, Shakhgildian fails to teach any of the five steps recited in claim 1. Regarding the claim limitation “determining a predominant direction of traffic,” the Examiner only vaguely alludes to this in his arguments that span pages 3 and 4. The Examiner states:

“If a short message data message is to be transmitted from the subscriber unit (determining a predominant direction of traffic with respect to the terminal).”

With all due respect, determining if a short message data message is to be transmitted from the subscriber unit is not equivalent to determining predominant direction of traffic with respect to the terminal. Determining a predominate direction of traffic involves determining if the predominant direction is uplink or downlink. In contrast, the test in Shakhgildian is whether or not a short message data message is to be transmitted from the subscriber unit. These are simply different and cannot be equated. The Examiner does not even address the claim limitation regarding “storing an uplink candidate set listing at least one candidate uplink base station” and “storing a downlink set listing at least one candidate downlink base station” in the rejection set out in paragraph 3 of the Detailed Action. Rather, the Examiner simply equates that selecting the base station with the best uplink performance when transmitting a short message data message is equivalent to “if the predominant direction of traffic is in an uplink direction, selecting at least one optimum base station from the uplink candidate set”. However, the Examiner has not established that such an uplink candidate set is even determined.

The Examiner goes on to argue that “with respect to the downlink direction of traffic, Shakhgildian teaches that cell selection based on downlink signal levels are known in the art. Thus it is obvious to a skilled artisan that a base station can be chosen based on the best downlink performance indicator if the subscriber unit requires a service such as downloading a data file”. With respect, this is simply hindsight reconstruction. Shakhgildian teaches that cell selection based on a combination of uplink and downlink signal levels for mixed traffic can be done. This is referred to as the “best combined performance” in column, lines 6 through 16 of

Shakhgildian. However, Shakhgildian does not teach cell selection from a downlink candidate set based on downlink signal levels alone as alleged by the Examiner. Shakhgildian does not teach ignoring uplink performance when performing cell selection. Rather, Shakhgildian teaches performing a cell selection based on only uplink or the combination of uplink and downlink, but does not suggest using the downlink alone. This is consistent with the fact that Shakhgildian does not teach determining the predomination direction of traffic, as discussed above.

Thus, when the Examiner provides the argument that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the prioritization algorithm of Ramos to distinguish candidate cells in the uplink and downlink direction and to allow cells to be chosen based on the best uplink/downlink performance indicator and the predominate direction of traffic, as taught by Shakhgildian in order to optimize system resource when a mobile device sends data in an uplink direction”, most of what the Examiner refers to as being taught by Shakhgildian is simply not there and as such the logic for combining the two references also fails.

The Examiner does address the candidate sets in the “Response to Arguments” section. The Examiner concedes that the combination of Ramos and Shakhgildian does not teach storing separate uplink and downlink candidate sets. See page 5, paragraph 4. This seems to be the end of the story. The Examiner agrees that the combination of Ramos and Shakhgildian does not teach storing separate uplink and downlink candidate sets. The Examiner concedes that a key claimed limitation is simply not taught in the combination of references. The Examiner argues the sets do not need to be “separate”, and argues a single candidate set reads on this limitation. It is respectfully submitted that a single candidate listing simply does not equate to “storing an uplink candidate set listing” and “storing a downlink candidate set listing”. In particular this is clear given that neither Ramos nor Shakhgildian performs cell selection based on downlink performance indicator alone and as such, of course such a candidate set listing does not need to be maintained.

The Examiner also addresses the limitation referring to the predomination direction of traffic in the “Response to Arguments” section. The Examiner concedes that there is no reference anywhere in Shakhgildian or Ramos to performing cell selection based on downlink performance. As such, there is no need to determine a predominate direction of traffic.

Shakhgildian only teaches using the uplink performance indicator in a particular scenario, namely when sending a short message. In other cases, a best combined performance is used.


The Review Panel is also referred to Applicant's detailed discussion of these issues in Applicant's response dated October 16, 2009.

The dependent claims contain further limitation not taught by Ramos or Shakhgildian. Furthermore, they should be allowable for their dependence upon one or more of each of the independent claims.

Applicant has established that many claimed limitations are not taught by the combination of references cited by the Examiner. It is respectfully submitted that this is clear on its face and the Review Panel is requested to overturn the Examiner's rejection of these claims.

Respectfully submitted,

BASSAM M. HASHEM, ET AL.

By 

Mark S. Starzomski

Reg. No. 62,441

Tel.: (613) 232-2486 ext. 323

Date: May 19, 2009

RAB:MSS:JFS:gcs:sng